

REMARKS

Claim 17 has been amended to correctly reference claim 11, rather than claim 1.

Claims 25, 39, 44, and 56 have also been amended to replace the term “comprising” with the phrase “consisting of.” No new matter has been added.

Applicants note that form PTO-326 mailed on June 26, 2003 (Paper No. 8) indicates that claims 1, 11, 17, 19, and 22-24 are withdrawn from consideration. However, the Detailed Action does not contain a response to the provisional election with traversal submitted April 24, 2003, nor does it indicate that such claims are withdrawn. Applicants respectfully request that the Examiner address the provisional election with traversal submitted April 24, 2003 in the next Office Action.

Claims 1, 11, 17, 19, and 22-58 are pending.

The Election of Species Requirement

Pursuant to Paper No. 8, mailed June 16 2003, the Examiner has required an election of a single disclosed species because “Claims 25 and 39 are generic to a plurality of disclosed patentably distinct species...” In particular, the Examiner contends that:

Because each of the different protein fragments has different amino acid sequences and is essentially a different protein, and Applicant is claiming more than one type of antibody. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

While Applicants disagree with the instant requirement, in order to be fully responsive, Applicants hereby elect, with traverse, the subject matter of an isolated antibody or fragment thereof that specifically binds to a protein consisting of amino acid residues 1 to 272 of SEQ ID NO:125, and to the equivalent residues encoded by the HCE5F43 cDNA contained in ATCC Deposit No. 209580. At least claims 25, 30-39, and 44-58 are generic, and at least claims 25-26, 30-40, and 44-58 read on the provisionally elected species. Applicants reserve the right to file one or more divisional applications directed to non-elected species should the election of species requirement be made final as a result of no generic claim being held allowable. Additionally, Applicants retain the right to petition from either the prior restriction requirement or the instant election of species requirement under 37 C.F.R. § 1.144.

With respect to the election of species requirement made by the Examiner, Applicants respectfully disagree and traverse. Even where patentably distinct inventions appear in a

single application, restriction (including election of species) is improper unless the examiner can show that the search and examination of these groups would entail a “serious burden.”

See M.P.E.P. § 803. In the present situation, although the Examiner contends that the claims are directed to patentably distinct species, Applicants respectfully assert that the search of the instant claims will include all antibodies to the protein of the invention. In particular, many, if not most, publications disclosing antibodies to a protein do not disclose the particular epitope(s) to which those antibodies specifically bind. As such, the search will require a text search using the term “antibody” and the known names for the protein of the invention, as well as a sequence-based search on the protein of the invention. Since such a search will encompass all of the species described by the Examiner, Applicants submit that it is not a serious burden to search and examine all of the species embraced by generic claims 25, 30-39, and 44-58. Nor would such a search be “unduly extensive and burdensome” as contemplated by M.P.E.P. § 808.01(a). Accordingly, the instant election of species requirement should be reconsidered and withdrawn.

Applicants also wish to draw the Examiner's attention to MPEP § 803.02, which instructs that after election of a species in a Markush type claim,

[t]he Markush-type claim would then be examined fully with respect to the elected species and any species considered to be clearly unpatentable over the elected species....should no prior art be found that anticipates or renders obvious the elected species, the search of the Markush-type claim will be extended....The prior art search will be extended to the extent necessary to determine patentability of the Markush-type claim.

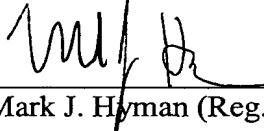
MPEP § 803.02 indicates that should the elected species of the Markush group be found allowable, that examination will be extended until at least one member of the Markush group is found not to be allowable or, alternatively, until all the members of the Markush group (and thus the entire Markush claim) are determined to be allowable. Thus, restriction of individual members of the Markush group does not result in withdrawal of the non-elected species from consideration by the Examiner unless at least one member of the Markush group is found not allowable over the prior art, and no rectifying amendment or convincing argument is made by the Applicant in response.

Thus, Applicants respectfully request that the Examiner reconsider and withdraw the requirement for a species election from claims 25 and 39. Applicants retain the right to petition from the election of species requirement under 37 C.F.R. § 1.144.

CONCLUSION

Entry of the above amendment and remarks is respectfully solicited. The Examiner is invited to call the undersigned at the phone number provided below if any further action by Applicant would expedite the examination of this application. If there are any fees due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 083425. If an extension of time under 37 CFR § 1.136 is required, such an extension is requested and the fee should also be charged to our Deposit Account.

Date: July 25, 2003



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